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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|-------------------------------|--------------------------|------------------------|
| 10/583,997 | 08/11/2008 | Soeren Flygenring Christensen | CHRISTENSEN9A | 1706 |
| 1444 7590 03/30/2010 BROWDY AND NEIMARK, P.L.L.C. 624 NINTH STREET, NW SUITE 300 WASHINGTON, DC 20001-5303 | | | EXAMINER NGUYEN, TU T | |
| | | | ART UNIT 2886 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/583,997 | Applicant(s) CHRISTENSEN ET AL. | |
| | Examiner TU T. NGUYEN | Art Unit 2886 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8,22,25,31 and 49-58 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8,22,25,31 and 49-58 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/20/2008</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Abstract

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The abstract has more than 150 words.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8,22,25,31,49-58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1,49-57, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claims 2-8,22,25,31,58 are also rejected as being depended on a rejected claim.

Claim Objections

Claims 1,22 are objected to because of the following informalities:

With respect to claims 1,22, the term “and/or” should be changed to “or”.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory

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double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8, 22, 25,31,49-58 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 66-77 of copending Application No. 12/160,306 ('306 hereinafter). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are anticipated by claims 66-77 of '306.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

With respect to claim 1, claim 1 discloses the same subject matter as taught in claim 66 of '306 in broader scope by eliminating the arrangement of the inlets, a guiding channel and the tilted planar capture body. However, it would have been obvious a design choice to modify claim 1 to have the eliminated limitations above for different intended uses. The modification involves only routine skill in the art.

With respect to claims 49-59, claims 49-59 disclose the same subject matter as taught in claims 73-77 of '306 except for detecting radiofrequency code of the beads. It

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would have been obvious to modify claims 49-59 with the step of analyzing the radiofrequency code to sort the beads easier.

With respect to claims 2-8, 22,25,31, the claims of '306 does not disclose all the limitations of claims 2-9,22,25,31. However, it would have been obvious a design choice to modify the claims of '306 to include all the limitations of claims 2-9,22,25,31 to measure different type of beads.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6,8,22,25,31,49-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugawara et al (WO 99/42209).

With respect to claim 1, Sugawara discloses an apparatus for measuring a plurality of optically detectable beads (title) comprising: a vacuum container 14 (fig 1) (the container is filled with fluid 14 so it is considered as a vacuum because there is no air in the container) comprising at least one planar capture body 40 (fig 1) or 42 (fig 2) capable of rotating around a central axis 75 (fig 2), wherein said capture body comprises a plurality of through-going inlets 58 (fig 2), a pressure controlling device P (fig 1) capable of controlling the pressure in the vacuum container, a device 100 (fig 1) for

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measuring at least one property of at least one bead.

Sugawara does not disclose the diameter of the inlets being around 0.4 mm. However, Sugawara does not disclose the diameter of each inlet being smaller than the average diameter of the beads to be measured. It would have been obvious to modify Sugawara's inlets having different diameter for measuring different size of beads.

Sugawara does not explicitly disclose rotating the vacuum container around the axis of the capture disc. Since Sugawara discloses rotating (see the arrows in fig 1) the fluid 14 (fig 1) by using two different pressure controller 36,34 (fig 1) and the fluid 14 (fig 1) could be considered as a container (the fluid contains the plate 42 (fig 2)), the claimed rotating the vacuum container would have been obvious.

With respect to claim 2, Sugawara does not disclose the diameter of each inlet as claimed. It would have been obvious to modify Sugawara's inlets having different diameter for measuring different size of beads.

With respect to claim 3, Sugawara discloses the capture body 42 (fig 2) is a planar disc.

With respect to claim 4, Sugawara discloses the distance between the axis of rotation 18 (fig 2) of the capture body and each of the through-going inlets 52 (fig 2) of the capture body is the same for each of the through-going inlets of the capture body.

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With respect to claim 5, since Sugawara discloses the inlets 52 (fig 2) being located at the same distance with other (see disc 42, fig 2), the claimed distance between neighbouring through-going inlets is the same for all pairs of neighbouring through-going inlets would have been obvious.

With respect to claim 6, Sugawara discloses a circular capture disc support 20 (fig 2) supporting the capture disc 42 (fig 2) at a distal end and being connected at a proximal end to a hollow shaft 18 (fig 2), wherein the hollow shaft is fitted with a shaft opening so that a vacuum can be applied to the interior of the vacuum container (fig 1).

With respect to claim 8, refer to discussion in claim 1 above for rotating the fluid inside the container. Sugawara does not disclose rotating the container by using a stepper motor. It would have been obvious to modify Sugawara by using a stepper motor for rotating container to transport the beads easier.

With respect to claim 22, Sugawara discloses an analysing device 100 (fig 1) for analysing results being generated from the measurement of the at least one property of the at least one bead (a bead under element 100 in fig 1), wherein said analysis enables individual beads to be characterised and/or identified and optionally also sorted.

With respect to claim 25, Sugawara disclose an apparatus for separating single beads from a group (title) so the claimed at least one device for sorting a plurality of beads on the basis of the result generated by the analysing device would have been inherent.

With respect to claim 31, Sugawara does not disclose a treating device for treating at least one bead optionally having been subjected to measuring or analysing. However, it would have been obvious to modify Sugawara with the claimed treating device to facilitate the measurement.

With respect to claims 49-58, refer to discussion in claim 1 above for the system. Since Sugawara discloses the claimed system, Sugawara would have been inherently disclose all the claimed methods for performing the measurement.

Allowable Subject Matter

Claim 7 would be allowable if applicant files in a Terminal Disclaimer, fix all the 112 rejection above and rewritten in independent form including all of the limitations of the base claim and any intervening claims.

With respect to claim 7, the prior art of record do not disclose a system comprising a vacuum container housing comprising an outer cylinder comprising an opening for connecting the shaft hole with the pressure controlling device, and a guiding plate comprising at least one opening allowing the through-going inlets to be accessible

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to beads to be loaded onto the capture disc, said guiding plate being attached to the top part of the outer cylinder, thereby defining in the space between the guiding plate and the capture disc a guiding channel for harbouring beads, said guiding plate confining the vacuum container to the interior of the vacuum container housing, in combination with all the limitations of the base claim.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TU T. NGUYEN whose telephone number is (571)272-2424. The examiner can normally be reached on T-F 7:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tarifur Chowdhury can be reached on (571) 272-2800 Ext. 86. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Tu T. Nguyen/
Primary Examiner, Art Unit 2886

03/28/2010